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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/741,678
Filing Date: December 19, 2003
Appellant(s): LANGE, BETH A.

MAILED
DEC 10 2007
GROUP 3700

Richard L. Bridge
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 26, 2007 appealing from the Office action mailed May 23, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,221,221	Ehrlich	9-1980
6,622,856	Gallo et al.	9-2003
6,405,867	Moore	6-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15, 23, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrlich (US Patent no. 4,221,221) in view of Gallo et al (US Patent no. 6,622,856). Ehrlich discloses a utility diaper structure 12 that includes a diaper assembly 14 having container

assemblies 16 connected by adhesive directly to the absorbent article 14, e.g., see col. 2 lines 43-44. The difference between the packaged assembly of Ehrlich and claim 29 resides in one of the container assemblies being a sunscreen carrier.

Gallo et al is cited for the teaching of kit of products including diapers and sunscreen, see col. 3, lines 39-40, col. 4 line 12 and col. 5, line 26. Hence to provide the combination sunscreen and diaper is suggested by Gallo et al. It would have been obvious to one of ordinary skill in the art to modify the assembly of Ehrlich by including a sunscreen composition as suggested by Gallo et al, in order to provide added protection utility to the assembly.

As to claim 15, the list of sunscreens compiled appears to encompass all conventional forms of the product that would be envisioned by general disclosure of Gallo et al.

As to claim 23, the absorbent article defined as a pair of swim pants is not distinguishable from the absorbent article of Ehrlich because diapers have been used as “swim pants” in pools.

Furthermore, a patentable distinction does not exist between diapers and swim pants because any difference would be a function of intended use. A reference that contains all the structure defined in a claim, but not the recited use anticipates the claim because a new use does not make an old product patentable, *In re Schreiber*, 128 F.3d 1473, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997).

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to the claims above, and further in view of Moore (Patent no. 6,405,867). Moore discloses a sunscreen carrier in addition a UV indicator that changes color as a display means integral with the sunscream carrier, e.g., see col. 1, lines 54-56, 60, 61.

It would have been obvious to one skilled in the art at the time the invention was made to modify the package of Gallo et al by employing a suncream carrier as taught by Moore, in order to provide a sunscreen that not only protects the user but informs one of the UV conditions and whether or not sufficient sunscreen protection is provided by the sunscreen product.

(10) Response to Argument

Claim 29 is directed to a packaged assembly of products considered as related to one another. A pre-packaged absorbent article and sun protection accessories arrangement is recited in claim 29 comprising an absorbent article for personal wear and a sunscreen carrier containing a sunscreen composition, the sunscreen carrier being releasably adhered directly to the absorbent article for distribution together as a single unit.

Ehrlich discloses a utility diaper structure having container assemblies connected thereto, col. 1, lines 19-22. Prior to the utility diaper structure of Ehrlich none of the prior art patents disclose a diaper structure having sealed, removable packets containing materials therein that are essential to the care of a human baby, col.1 lines 13-16. In this regard Appellant argues that typically the caregiver commonly loads the personal wear absorbent articles along with all the accessories into a bag or other carrier. This requires the caregiver to remember to purchase, store, and gather all the separate items together into the carrier. More importantly, even where the caregiver remembers to bring the sunscreen the caregiver may forget to apply the sunscreen to the infant. Hence, it is acknowledged that the purchase of diapers along with sunscreen is fairly common place particularly where a parent, or caregiver, in preparing for an outing such as to a swimming pool. Thus, a diaper and sunscreen are not totally unrelated products for a particular circumstance even though both have diverse functions. It is not agreed the pre-packaged assembly of claim 29 is directed to two independent, wholly unrelated products.

Appellant also argues releasably securing the sunscreen to the absorbent articles serves as a reminder to the caregiver, upon changing the absorbent article, to apply/reapply sunscreen to the child. However, this is nothing more than an inherent function of the utility diaper structure of Ehrlich. The container assemblies attached to the diaper structure of Ehrlich manifestly serves as a reminder to apply the container assembly contents when the diaper is applied. When the diaper is used one detaches the packet assemblies which can be attached to the diaper, each packet members holding a material therein to be used in baby maintenance, col. 1, lines 55-58 of Ehrlich.

Appellant argues nowhere does Ehrlich teach or suggest releasably securing, onto a diaper, any products that are wholly unrelated to the diaper and the diaper changing process, let

alone sunscreen as recited in present claim 29, page 5 of brief. While this sounds convincing, it is not what Ehrlich teaches. Col.3, lines 37-41 states "While the invention has been described in conjunction with the preferred specific (emphasis added) embodiments thereof, it will be understood that this description is intended to illustrate and not to limit the scope of the invention, which is defined by the following claims". And what do the claims of Ehrlich ascribe? A diaper structure having a container assembly having a baby maintenance item sealed therein, see claim 1 of Ehrlich. This is also consistent with col. 1, lines 44-46 where an object of the invention of Ehrlich is to provide a diaper structure having removable container assemblies thereon to hold baby maintenance items thereon. While a specific embodiment shows container assemblies in a "pre-packaged" form located on the diaper that would involve products one would expect as being associated with a diaper changing operation, the disclosure of Ehrlich is much broader. Encompassing container assemblies pertaining to baby maintenance. Given the broad disclosure of Ehrlich and the level of ordinary skill in the art it is questionable whether a secondary teaching is necessary to establish *prima facie* obviousness of the invention inasmuch as is claimed.

Nonetheless, Gallo et al is cited for the teaching of a kit of items including the association of sunscreen with diapers. It is not agreed Gallo et al adds little to Ehrlich but is particularly pertinent in teaching items that could be characterized as associated with baby, or infant, care. Care of such children including but not limited to fever, pain, congestion, gas, skin irritation and irritability, col. 1, lines 6-10. If Gallo et al can be said to represent the state of the art then it appears a wide variety of products can be grouped together for the care of a child. So much so that new parents are frequently overwhelmed at the number of products to care for the comfort of a child, col. 1, lines 12-14. Gallo et al suggests that, depending upon the needs of a child, one often purchases products associated with child care. For example when a child catches cold, it is common to purchase cold medicine, col. 1, lines 18-22. If a child has diaper rash it common to purchase ointments, col. 1, lines 29-32. If a baby suffers from discomfort from gas pain, parents frequently purchase products and give them to the baby to relieve gas pain, col. 1, lines 33-35. It stands to reason that if a child needs protection from the sun parents would purchase products that give sun protection. It is common to take infants/small children to places where such

protection is needed such as beaches, pools, concerts, festivals or merely outdoors. Parents also frequently apply sunscreen to the child for protection from the possible adverse effects of being outdoors. Rather than purchasing the products individually Gallo et al recognizes the need to provide child comfort care in a kit that conveniently provides products needed to relieve children from discomfort and organizes them in an effective manner. Hence, one skilled in the art would be motivated to provide child care products in a single collection as suggested by Gallo et al. Gallo et al recognizes the use of a sunscreen product in child care, it is *prima facie* obvious to merely modify the container of Ehrlich by including such a product.

While it is recognized Gallo et al does not disclose the sunscreen directly secured to an absorbent article, the question of obviousness is what the prior art, taken as a whole suggests. Ehrlich does show the containers 16 directly applied to the absorbent article and in keeping with that teaching it is the sunscreen that would have been included for one of the container assemblies that is secured to the absorbent article. Accordingly, there is no distinction between claimed subject matter and the prior art, taken as a whole, in this capacity. For these and the above reasons it is submitted claim 29 is not patentable over the references of record.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present instance nothing is gleaned from Appellants disclosure in the reconstruction illustrated above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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